

30 SEP 2003

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In re Application of
ANDERSON, et al.
Application No.: 09/937,232
Filing Date: 24 September 2001
Attorney Docket No.: P63654USW
For: VALVE

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DECISION

This is a decision on applicants' "Petition to Commission for Reconsideration of Decision on Petition of PCT Legal Office under 37 CFR 1.181" filed 08 November 2002 and facsimile communication filed 11 August 2003 requesting that the above captioned application be treated as a U.S. national stage application. The petition has been treated as a Petition under 37 CFR 1.182. The petition fee has been charged to Deposit Account no. 07-1392.

BACKGROUND

On 23 February 2000, applicants filed international application no. PCT/EP00/01444 which claimed a priority date of 24 March 1999. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 24 September 2001.

On 24 September 2001, applicants filed a Transmittal Letter for entry into the national stage accompanied, *inter alia*, by: the requisite basic national fee; a copy of the international application; a "Preliminary Amendment Under 35 U.S.C. 111"; and an executed declaration.

On 30 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) which set forth a 35 U.S.C. 371 completion date of 24 September 2001.

On 30 July 2002, applicants filed "Petition to Accept an Unintentionally Delayed Priority Claim under 37 C.F.R. 1.78(a)(3)."

On 25 September 2002, the Office PCT Legal Administration mailed "Notification" which indicated that the application was being processed under 35 U.S.C. 111 and vacated the "Notification of Acceptance of Application" mailed 30 October 2001.

On 08 November 2002, applicants filed Petition to Commission for Reconsideration of Decision on Petition of PCT Legal Office under 37 CFR 1.181.

On 22 August 2003, applicants filed a facsimile communication which included a copy of the petition filed 08 November 2002.

DISCUSSION

As stated in the previous notification, any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.495(g):

The documents and fees submitted . . . must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a), page 1800-114 of the MPEP states that:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

Applicants request in the present petition that the application be treated as a national state application under 35 U.S.C. 371. Additionally, applicants state that the submission of the basic national fee, transmittal form (PCT/DO/EO/1390), and an oath/declaration which identifies the international applicant letter was an "unquestionable" intention to enter the national stage as opposed to a 111(a) filing. However, applicants' reference to a Preliminary Amendment Under 35 U.S.C. 111 filed 24 September 2001 is inconsistent with and contradicts the desire expressed in the transmittal letter to enter the national stage of the PCT under 35 U.S.C. 371. The reference in the Preliminary Amendment to "35 U.S.C. 111" is considered a conflicting instruction. Accordingly, the original papers deposited on 24 September 2001 contained conflicting instructions and constituted a filing under 35 U.S.C. 111.

Additionally, applicants assert the Official Gazette at 1077 O.G. 13 (14 April 1987) which states,

if the applicant files a U.S. national application and clearly identifies in the accompanying oath or declaration the specification to which it is directed by referring to a particular international application by PCT Application Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application, then the application will be accepted as filed under 35 U.S.C.

371. Merely claiming priority of an international (PCT) application in an oath or declaration will not serve to indicate a filing under 35 U.S.C. 371. **Also, if there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).**

In this case, applicants filed a declaration claiming priority of an international application and a "Preliminary Amendment Under 35 U.S.C. 111" and due to the conflicting instructions, it was unclear whether the application was being filed under 35 U.S.C. 371 or 35 U.S.C. 111(a). Therefore, applicants' paper deposited on 24 September 2001 should have been treated as a filing under 35 U.S.C. 111(a).

CONCLUSION

The petition under 37 CFR 1.182 is **DISMISSED** without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.182."

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being returned to the Technology Center 3754.



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